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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/617,530
Filing Date: July 10, 2003
Appellant(s): CHEN ET AL.

Rudolph O. Siegesmund
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 June 2009 appealing from the Office action mailed 08 April 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application No. 10/617,526 and Application No. 10/631,070 are related and on appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The rejections of claims 1 – 5, 9 – 12, 16 – 20, and 24 – 27 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement are withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Chinese-English Dictionary,
<http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html>.

Chinese-English Lookup,
<http://web.archive.org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm>.

Hughes "1ICT3 Computer Science Sample Paper I", 1998, University of Dublin.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 – 5, 9 – 12, 16 – 20, and 24 – 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 16, and 30 – 45 of copending Application No. 10/617,526 in view of Chinese-English Dictionary

(<http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html>) and in further view of Chinese-English Lookup

(<http://web.archive.org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm>) referred as Lookup hereinafter.

Current Application	Co-pending Application 10/617,526
<p>1. A method comprising: using a computer having a display and connected to the internet, copying a Chinese character from a web page by highlighting the Chinese character on the web page;</p> <p>accessing a graphical user interface having only an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area;</p> <p>pasting the Chinese character into an input field of a graphical user interface on the display;</p> <p>responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Traditional Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character, and when the Chinese character is a Traditional Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Simplified Chinese</p>	<p>1. A method comprising: using a computer having a display and connected to the internet, copying a Simplified Chinese character into an input field of a graphical user interface;</p> <p>using Unicode to determine a Traditional Chinese character equivalent of a Simplified Chinese character;</p> <p>using Unicode to translate the Simplified Chinese character into accented Pin Yin word and an English word; and responsive to a user activation of a single control on the graphical user interface,</p> <p>simultaneously displaying the Simplified Chinese character as a Traditional Chinese character, an unaccented Pin Yin word, a hybrid Pin Yin word, and an English word.</p>

<p>character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the.</p> <p>2. The method of claim 1 further comprising: accepting the Chinese character as user input, wherein the Chinese character is encoded in GB2312 or Unicode.</p> <p>3. The method of claim 1 further comprising: translating the Chinese character from GB2312 to Unicode.</p> <p>4. The method of claim 1 further comprising: accessing a conversion table to determine the Traditional Chinese character.</p> <p>5. The method of claim 4 wherein the conversion table is a JAVA hashtable.</p>	<p>2. The method of claim 1 further comprising: accepting the Simplified Chinese character as user input, wherein the Simplified Chinese character is encoded in GB2312 or Unicode.</p> <p>3. The method of claim 1 further comprising: translating the Simplified Chinese character from GB2312 to Unicode.</p> <p>4. The method of claim 1 further comprising: accessing a conversion table to determine the Traditional Chinese character.</p> <p>5. The method of claim 4 wherein the conversion table is a JAVA hashtable.</p>
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The current application is directed to finding the corresponding Chinese character (Traditional and/or Simplified) to a given Chinese word (Traditional and/or Simplified). Copending application No. 10/617,526 is directed to finding the corresponding equivalent Chinese character (Traditional and/or Simplified), the corresponding Pin Yin word, and/or an English word to any given word (Chinese, Pin Yin, and/or English).

Chinese-English Dictionary teaches a method of finding the corresponding equivalent Chinese character (Traditional and/or Simplified), the corresponding Pin Yin word, and/or an English word to any given word (Chinese, Pin Yin, and/or English) without regard to an encoding format ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ...", page 1, lines 5-6).

Lookup discloses simultaneously displaying a Chinese character first and its translations next to the Chinese character in a graphical user interface without entering an encoding format of the Chinese character (Figure on top of page 1. Note the display of a Chinese character first and its translations next to the Chinese character).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to include Chinese-English Dictionary's various translations in order to help a non-native Chinese speaker learn the Chinese language by, for example, giving English translations to Chinese words.

It would have also been obvious to one with ordinary skill in the art at the time of the invention to simultaneously display Applicant's Chinese character (Simplified or Traditional) and its translations as disclosed in Lookup. It would also have been obvious to limit the graphical user interface (GUI) to an input field, a submit control, and an equivalency display area in order to provide a simple GUI void of unnecessary encumbrances.

Claims 16 – 20, and 24 – 27 are similar in scope and content to claims 1 – 5 and 9 – 12 and are rejected with the same rationale.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1 – 3, 9, 10, 16 – 18, 24 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5 – 6, 26, 30 – 31 of copending Application No. 10/631,070 in view of Chinese-English Dictionary

(<http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html>) and in further view of Chinese-English Lookup

(<http://web.archive.org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm>).

Current Application	Co-pending Application 10/631,070
<p>1. A method comprising: using a computer having a display and connected to the internet, copying a Chinese character from a web page by highlighting the Chinese character on the web page;</p> <p>accessing a graphical user interface having only an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area;</p> <p>pastng the Chinese character into an input field of a graphical user interface on the display;</p> <p>responsive only to pastng the Chinese character into the input field of the</p>	<p>1. A method comprising: using a computer having a display and connected to the internet,</p> <p>accepting a user input of a Simplified Chinese word at a graphical user interface on the display;</p> <p>...</p> <p>searching a dictionary for an entry containing a Simplified Chinese word; using Unicode to determine a Traditional Chinese word equivalent of a Simplified Chinese word;</p> <p>using Unicode to translate the Simplified Chinese word into accented Pin Yin word</p>

<p>graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Traditional Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character, and when the Chinese character is a Traditional Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Simplified Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the.</p> <p>2. The method of claim 1 further comprising: accepting the Chinese character as user input, wherein the Chinese character is encoded in GB2312 or Unicode.</p> <p>3. The method of claim 1 further comprising: translating the Chinese character from GB2312 to Unicode.</p>	<p>and an English word; and</p> <p>responsive to a user activation of a single control on the graphical user interface, simultaneously displaying the Simplified Chinese word, the Traditional Chinese word equivalent, the accented Pin Yin word, and the English word.</p> <p>5. The method of claim 1 further comprising: accepting the Simplified Chinese word as user input, wherein the Simplified Chinese word is encoded in GB2312 or Unicode.</p> <p>6. The method of claim 1 further comprising: translating the Simplified Chinese word from GB2312 to Unicode.</p>
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The current application is directed to finding the corresponding Chinese character (Traditional and/or Simplified) to a given Chinese word (Traditional and/or Simplified). Copending application No. 10/631,070 is directed to finding the

corresponding equivalent Chinese character (Traditional and/or Simplified), the corresponding Pin Yin word, and/or an English word to any given word (Chinese, Pin Yin, and/or English).

Chinese-English Dictionary teaches a method of finding the corresponding equivalent Chinese character (Traditional and/or Simplified), the corresponding Pin Yin word, and/or an English word to any given word (Chinese, Pin Yin, and/or English) without regard to an encoding format and where Chinese character is determined without the use of an intermediate language ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word", page 1. Note that the Chinese word can be selected to be either Simp. Chinese (GB) or Trad. Chinese (Big5) as shown on top of page 1).

Lookup discloses simultaneously displaying a Chinese character first and its translations next to the Chinese character in a graphical user interface (Figure on top of page 1. Note the display of a Chinese character first and its translations next to the Chinese character).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to include Chinese-English Dictionary's various translations in order to help a non-native Chinese speaker learn the Chinese language by, for example, giving English translations to Chinese words.

It would have also been obvious to one with ordinary skill in the art at the time of the invention to simultaneously display Applicant's Chinese character (Simplified or Traditional) and its translations as disclosed in Lookup. It would also have been obvious

to limit the graphical user interface (GUI) to an input field, a submit control, and an equivalency display area in order to provide a simple GUI void of unnecessary encumbrances.

It is also noted that it is well settled that the omission of an element/step and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element or step whose function is not needed would be obvious to one of ordinary skill in the art.

Claims 16 – 18, 24 and 25 are similar in scope and content to claims 1 – 3, 9, and 10 and are rejected with the same rationale.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 4, 9 – 11, 16 – 19, and 24 – 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary (<http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html>) in view of Chinese-English Lookup

(<http://web.archive.org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm>).

Claim 1:

Chinese-English Dictionary discloses a method comprising:

using a computer having a display and connected to the internet (Figure on page 1, related text, and "download the dictionary at the CEDICT website", page 1);

accessing a graphical user interface having an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area ("Search" and "Look It Up" in Figure on page 1 and "Results will show ...", page 1, lines 4-7).

But Chinese-English Dictionary does not explicitly disclose copying a Chinese character from a web page by highlighting the Chinese character on the web page, pasting the Chinese character into an input field of a graphical user interface, automatically recognizing the Chinese character without entering an encoding format of the Chinese character, and displaying as claimed in the instant claim.

Lookup discloses a similar Chinese-English dictionary where a user is able to select and copy a Chinese character (where it is pasted on the dictionary window) from a Web browsers or a word processor ("user has selected and copied a word ...", page 1) in order to get a desired translation by automatically recognizing the Chinese character without entering an encoding format of the Chinese character (see "Does CEL work with both Big5 and GB text?", page 2) and simultaneously displaying the Chinese character and the translated characters next to the Chinese character in a graphical user interface in response to only pasting the Chinese character into a window and

clicking a control (Figure on top of page 1. Note the display of a Chinese character and its translations next to the Chinese character. See also "What's new in Version 2.0?" on page 1 where it is disclosed that the user can manually, i.e. by clicking a control, paste the Chinese character and trigger the lookup dictionary).

It would have been obvious to one with ordinary skill in the art at the time of the invention to copy and paste words from Web pages in Chinese-English Dictionary's interface, automatically recognizing the Chinese character without entering an encoding format of the Chinese character, and simultaneously displaying the Chinese character and the translated characters next to the Chinese character in Chinese-English Dictionary's interface in response to only pasting the Chinese character into an input field and clicking a submit control in order to "help Chinese language learners to read Chinese electronic texts in other applications such as Web browsers and word processors" (Lookup, page 1, paragraph 2).

Chinese-English Dictionary and Lookup do not explicitly disclose a graphical user interface (GUI) having only an input field, a submit control, and an equivalency display area. However, it would have been obvious to one with ordinary skill in the art at the time of the invention to have excluded unnecessary fields from the Chinese-English Dictionary's GUI in order to present a simple interface void of unused fields. For instance, the "as" field in Chinese-English Dictionary where a user selects the encoding type of the entered Chinese character will be unnecessary in the combination of Chinese-English Dictionary with Lookup, because the combination, using Lookup's method, is able to automatically discern the entered Chinese character's encoding. The

"Output as" field will also be unnecessary because the combination of Chinese-English Dictionary with Lookup is able to display the Chinese character and all its translations so the user is not required to select which particular translations should be displayed. The "Look for" field which is used to select the position of the entered Chinese character is not a mandatory field for translation in Chinese-English Dictionary, it is simply a way to limit searches. This field could be omitted without affecting Chinese-English Dictionary's basic translation capabilities. It is again noted that it is well settled that the omission of an element/step and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note Ex parte Rainy, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element or step whose function is not needed would be obvious to one of ordinary skill in the art.

Claim 2:

Chinese-English Dictionary and Lookup disclose the method of claim 1, Chinese-English Dictionary further discloses: accepting the Chinese character as user input, wherein the Chinese character is encoded in GB2312 or Unicode ("return the results in GB ... or Unicode", page 1).

Claim 3:

Chinese-English Dictionary and Lookup disclose the method of claim 1, Chinese-English Dictionary further discloses: translating the Chinese character from GB2312 to Unicode ("return the results in GB ... or Unicode", page 1).

Claim 4:

Chinese-English Dictionary and Lookup disclose the method of claim 1, Chinese-English Dictionary further discloses: accessing a conversion table to determine the Traditional Chinese character ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word", page 1. Note that a conversion table is inherent in the determination of equivalent characters).

Claim 9:

Chinese-English Dictionary and Lookup disclose the method of claim 1, Chinese-English Dictionary further discloses: accepting the Chinese character as user input, wherein the Chinese character is encoded in Big5 ("return the results in GB, Big5 ... Unicode", page 1).

Claim 10:

Chinese-English Dictionary and Lookup disclose the method of claim 1, Chinese-English Dictionary further discloses: translating the Chinese character from Big5 to Unicode ("return the results in GB, Big5 ... Unicode", page 1).

Claim 11:

Chinese-English Dictionary and Lookup disclose the method of claim 1, Chinese-English Dictionary further discloses: accessing a conversion table to determine the Simplified Chinese character ("searches can be conducted by Chinese (using either the GB, Big5, or Unicode encodings), ... results will show the Chinese word", page 1. Note that a conversion table is inherent in the determination of equivalent characters).

Claims 16 – 19 and 24 – 26:

Claims 16 – 19 and 24 – 26 are directed to a program product encoding program code for performing the method of claims 1 – 4 and 9 – 11. It is old and well-known to encode program code for performing a method on a computer storage medium and implement instructions corresponding to the program code on a computer's processor. Accordingly, claims 16 – 19 and 24 – 26 are rejected with the same rationale as applied above with respect to method claims 1 – 4 and 9 – 11.

6. Claims 5, 12, 20, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary (<http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html>) in view of Chinese-English Lookup (<http://web.archive.org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm>) and in further view of Hughes ("1ICT3 Computer Science Sample Paper I", 1998, University of Dublin).

Claim 5:

Chinese-English Dictionary and Lookup disclose the method of claim 4, but they do not explicitly disclose using a Java hashtable.

Hughes discloses a conversion table for Morse code stored in a Java hashtable ("The conversion table for Morse code can be stored in a Java Hashtable object", page 4, question 6).

Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to use a Java hashtable as the conversion table in Chinese-English Dictionary because Java is able to run on any platform.

Claim 12:

Claim 12 is similar in scope and content to claim 5; therefore it is rejected with the same rationale.

Claims 20 and 27:

Claims 20 and 27 are directed to a program product encoding program code for performing the method of claims 5 and 12. It is old and well-known to encode program code for performing a method on a computer storage medium and implement instructions corresponding to the program code on a computer's processor. Accordingly, claims 20 and 27 are rejected with the same rationale as applied above with respect to method claims 5 and 12.

(10) Response to Argument

Regarding the rejections of claims 1 – 5, 9 – 12, 16 – 20, and 24 – 27 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 16, and 30 - 45 of copending Application No. 10/617,526 in view of Chinese-English Dictionary (<http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html>) and in further view of Chinese-English Lookup (<http://web.archive.org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/>

cel.htm), Appellants argue that the limitation, in claims 1 and 16, "responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character" is not anticipated or rendered obvious by the claims of co-pending 10/617,526 (Appeal Brief, page 11). However, the rejection is not made simply over the claims of co-pending 10/617,526 but over the claims of 10/617,526 in view of Chinese–English Dictionary and Lookup. Appellants' arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the claims of 10/617,526 in view the references. Further, Appellants note that section D of the Brief explains the non-obviousness of claims 1 and 16 (Appeal Brief, page 11). However, the arguments in section D, as they relate to claims 1 and 16, are geared towards the alleged non-obviousness of the claims over Chinese–English Dictionary in view of Lookup. The arguments are completely silent regarding the recitations of the claims of 10/617,526 in view of the references.

Regarding the rejections of claims 1 – 3, 9, 10, 16 – 18, 24 and 25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5 – 6, 26, 30 – 31 of copending Application No. 10/631,070 in view of Chinese-English Dictionary

(<http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.ht>

ml) and in further view of Chinese-English Lookup

(<http://web.archive.org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm>), the same arguments as the ones put forth above by the Examiner in the nonstatutory obviousness-type double patenting of co-pending application 10/617,526 apply.

Regarding the rejections of claims 1 – 4, 9 – 11, 16 – 19, and 24 – 26 under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary (<http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.htm>) in view of Chinese-English Lookup (<http://web.archive.org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm>), Appellants argue that the “as” field (what Appellants have named A1) in the Chinese-English Dictionary graphical user interface (GUI) cannot be eliminated from the GUI without changing the method of operation and that the elimination would not have been obvious to one with ordinary skill in the art (Appeal Brief, page 18).

The Examiner respectfully disagrees. The “as” field is used to provide the encoding format of the Chinese character translated into a target language in Chinese-English Dictionary (“as” in Figure on page 1 and related text). On the other hand, Lookup discloses a translation method where the encoding format of the Chinese character is automatically discerned without requiring input from a user as in Chinese-English Dictionary (see “Does CEL work with both Big5 and GB text?”, page 2). It would have been obvious to one with ordinary skill in the art to have used Lookup’s automatic

encoding detector in Chinese-English Dictionary keeping its method of operation, which is natural language translation. It would have also been obvious to one with ordinary skill in the art to remove the "as" field because Chinese-English Dictionary using Lookup's automatic encoding detector would not need a user to enter a character's encoding format. Again note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element or step whose function is not needed would be obvious to one of ordinary skill in the art.

Further, Appellants argue that the Examiner has set forth no technical argument to show how Lookup and Chinese-English Dictionary can be modified to produce a GUI as claimed by Appellants (Appeal Brief, page 19). However, the Examiner has indeed done just that in the rejection of claim 1 under 35 U.S.C. 103(a) as follows:

The "as" field in Chinese-English Dictionary where a user selects the encoding type of the entered Chinese character will be unnecessary in the combination of Chinese-English Dictionary with Lookup, because the combination, using Lookup's method, is able to automatically discern the entered Chinese character's encoding. The "Output as" field will also be unnecessary because the combination of Chinese-English Dictionary with Lookup is able to display the Chinese character and all its translations so the user is not required to select which particular translations should be displayed. The "Look for" field which is used to select the position of the entered Chinese character is not a mandatory field for translation in Chinese-English Dictionary, it is simply a way to limit searches. This field could be omitted without affecting Chinese-English

Dictionary's basic translation capabilities. It is again noted that it is well settled that the omission of an element/step and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element or step whose function is not needed would be obvious to one of ordinary skill in the art.

Appellants also argue that their invention is about Simplified Chinese/Traditional Chinese equivalency and that Lookup wholly fails to address this issue. However, it is Chinese-English Dictionary (not Lookup) which is relied upon to teach Simplified Chinese/Traditional Chinese equivalency ("Search" and "Look It Up" in Figure on page 1 and "Results will show ...", page 1, lines 4-7).

Regarding the rejections of claims 5, 12, 20, and 27 under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary (<http://web.archive.org/web/20000301054545/http://www.mandarin-tools.com/worddict.html>) in view of Chinese-English Lookup (<http://web.archive.org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm>) referred as Lookup hereinafter and in further view of Hughes ("1ICT3 Computer Science Sample Paper I", 1998, University of Dublin), Appellants submit that Hughes is not in a related field and that it would not be obvious to look to Morse Code in designing a Chinese equivalency tool (Appeal Brief, page 21). However, Hughes is also concerned with natural language translation, namely translating words represented in

Morse code into English words (page 4, question 6 (b)) and it would have therefore been obvious to one with ordinary skill in the natural language translation art to have considered Hughes.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Samuel G. Neway

/S. G. N./

/David R Hudspeth/
Supervisory Patent Examiner, Art Unit 2626

Conferees:

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